

US Serial No. 10/530427
Page 6 of 19

Remarks:

Regarding the Restriction Requirement:

At the outset, the applicant continues TRAVERSES the Examiner's requirement as to the election between the Group I claims (claims 1-6, 8-15, 21-23 and 25) and the Group II claims (claims 19 and 20) as in the applicant's view that no undue burden is placed upon the Examiner in performing a search of the prior art concurrently dealing with the subject matter of the claims. Thus it is the applicant's position that a contemporaneous search of the claims may be easily performed by the Examiner with sufficient scope to address and encompass the subject matter of the Group I and Group II claims.

Although the applicant is of the position that the division of the claims in to separate groups is improper for the reasons discussed above, in order to comply with 37 CFR 1.143, the applicant provisionally elects the subject matter of the Group I claims drawn to aqueous hard surface cleaning compositions for further prosecution in the instant application. In compliance therewith, the applicant has amended the claims indicating that the Group II claims are now withdrawn.

Regarding the claim objections:

The applicant has amended the claims to address the issues raised by the Examiner with respect to claims 4 and 10; claims 4 and 10 are canceled herein which renders the Examiner's rejection moot.

Prior to discussing the prior art documents cited by the Examiner, the applicant notes that an important aspect of their invention resides in the surprising discovery that compositions comprising both an alkali metal hydroxide and an organic solvent selected from alcohols, glycol ethers and mixtures thereof which imparts to said composition germicidal efficacy against both Gram positive and Gram negative bacteria which is unexpected in the prior art. This surprising effect is particularly pronounced when the

US Serial No. 10/530427
Page 7 of 19

organic solvent system is one of the two particularly preferred organic solvents, namely benzyl alcohol and propylene glycol phenyl ether. This effect is unexpected and is observed in compositions which include additional constituents, e.g., one or more surfactants particularly anionic surfactants, and in the presence of soap as well. Such efficacy is provided even in the absence of conventional germicidal or biocidal compounds. These effects are observed when the compositions are used in both their undiluted, as well as in certain dilutions as well. The efficacy of the compositions according to the invention, especially preferred embodiments thereof are demonstrated in the Examples forming part of the patent application.

Regarding the rejection of claims 1-6, 8 and 25 under 35 USC 102(b) as being anticipated by US 6001795 to Charlez (hereinafter "Charlez"):

The applicant respectfully traverses the Examiner's rejection of the claims over the Charlez reference.

Whereas the Charlez reference compositions are also useful in the treatment of hard surfaces, there is no teaching or suggestion of any antimicrobial benefits which are provided by that composition. As such, it is not seen how the Charlez reference can be considered to be applicable as it fails to teach or suggest that its compositions have any antimicrobial or germicidal benefit, much less any reasonable degree of efficacy against both Gram positive and Gram negative bacteria.

The applicant's presently amended claims require a "germicide system" which comprises both both an alkali metal hydroxide and an organic solvent selected from alcohols, glycol ethers and mixtures thereof. Charlez fails to provide any suggestion or demonstration of any such effect and thus it not believed to anticipate the present invention.

US Serial No. 10/530427
Page 8 of 19

The Examiner is again respectfully reminded that with regard to lodging a rejection based on obviousness section MPEP 2143 states that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, unpatentability based on "anticipation" requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a single reference describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). It is the applicant's view that these criteria are not met. Accordingly withdrawal of the grounds of rejection is deemed to be proper.

Regarding the rejection of claims 1-6, 8-11, 13 and 15 under 35 USC 102(b) as being anticipated by US 2002/0069901 to Evers (hereinafter "Evers"):

The applicant respectfully traverses the Examiner's rejection of the claims over the Evers reference.

Evers' compositions are also relevant only insofar that they relate to a composition useful in the cleaning of a hard surface. This document's 17 pages are indeed quite expansive and describe most commercially relevant chemical compounds and compositions which may find some use in a hard surface cleaning composition. However, they do not teach

US Serial No. 10/530427
Page 9 of 19

or suggest that applicant's invention, as nowhere does Evers indicate that any of his compositions exhibit antimicrobial efficacy against either Gram positive or Gram negative bacteria, nor does Evers describe the applicants' presently claimed "germicide system". With regard to Evers' constituents, concerning his surfactants, at page 4, paragraph [0055] the surfactant system necessarily consists of a sulfate or sulfonated anionic surfactant, a neutralizing co-surfactant (betane, sulfobetane, amine oxide surfactants) and an alkoxyated nonionic surfactant is necessarily present. Further the Evers compositions also necessarily require a polymer (see paragraphs [0096]-[0139]) a large list of further "optional" ingredients may also be present. These include for example fatty acids (see paragraphs [0144]-[0149]) However, Evers is silent as to any specific identification of the specific constituents which would need to be selected from countless combinations of materials which might be produced from his expansive specification in order to arrive at the applicant's "germicide system", particularly as Evers is mute to any germicidal efficacy or the need for the same. As such, it is believed that the Examiner's continued reliance upon the Evers reference is inappropriate and withdrawal of the rejection in light of the presently amended claims is solicited.

Regarding the rejection of claims 1-6, and 9-11 under 35 USC 102(h) as being anticipated by EP478086:

The applicant respectfully traverses the Examiner's rejection of the claims over this EP reference.

The specific invention of these prior art compositions is very accurately described by the applicant when they recite:

"In accordance with the present invention a microemulsion detergent composition comprises a disinfecting bleaching proportion of hypochlorite, a deterative proportion of a mixture of higher alcohol sulfate and higher paraffin sulfonate detergents, a soil removal promoting and microemulsion initiating proportion of a water insoluble lipophile, an aqueous medium and a microemulsion formation promoting proportion of a co-surfactant for the lipophile and the aqueous medium,

US Serial No. 10/530427
Page 10 of 19

which microemulsion is of improved hypochlorite stability and is of improved soil removing power, when diluted with water, compared to other hypochlorite-containing microemulsions and solutions, and emulsions of other detergents, lipophiles, co-surfactants and water, when similarly diluted. Also within the invention are processes for manufacturing such microemulsion detergent compositions and for using them."

With regard to the relevance of said prior art composition to the applicant's presently claimed invention, a close review indicates that there is little or no relevance. A review of the prior art document makes quite plain that it requires the hypochlorite to be the germicidally effective active agent whereas, the presently claimed compositions do not require hypochlorite but rather are effective with the presently claimed "germicide system" which is effective against both Gram positive and Gram negative bacteria even in the absence of any of the conventional germicidally effective active agents. As such it is clear to see that this EP reference fails to anticipate, or even suggest the presently claimed invention. Accordingly reconsideration of the propriety of the rejection and its withdrawal is solicited.

Regarding the rejection of claims 1-6, 8-13 and 15 under 35 USC 102(h) as being anticipated by WO94/14945 reference:

The applicant respectfully traverses the Examiner's rejection of the claims over this WO reference.

A skilled artisan reviewing this document would understand that this application is generally directed to a hard surface cleaning composition which however has a neutral pH. The required pH range is indicated at the top of page 2 of the specification and (in translation) reads..."lies within the range of pH values 5 and 9, especially between 6 and 8, are foreseen." However the document is completely silent as to any germicidal efficacy or of any germicidal benefit provided by those compositions. Clearly the WO 94/14945 document fails to disclosed the applicant's presently claimed "germicide system" which is effective against both Gram positive and Gram negative bacteria even

US Serial No. 10/530427
Page 11 of 19

in the absence of any of the conventional germicidally effective active agents. As such it is clear to see that this WO reference fails to anticipate, or even suggest the presently claimed invention.

The present applicant also points out that a new dependent claims has been introduced which require a pH above the maximum pH of the WO94/14945 reference. Thus the presently amended claims are not anticipated by this document.

In view of the foregoing, reconsideration of the continued relevance of the rejection and its withdrawal is solicited.

Regarding the rejection of claims 9-11, 13 and 15 under 35 USC 103(a) as being considered obvious in view of US 6001795 to Charlez:

The applicant respectfully traverses the Examiner's rejection of the claims over the Charlez reference.

Prior to discussing the Charlez reference, the Examiner is respectfully reminded that with regard to any rejection based on obviousness under 35 USC §103(b), MPEP section 2143 states that three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Rouffet*, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998).

US Serial No. 10/530427
Page 12 of 19

The applicant herein repeats the remarks entered, *supra*, with respect to the rejection under 102(b) in view of the Charlez document as being equally relevant to the current obviousness-type rejection. Herein the applicant adds that as the Charlez document fails to teach or to even suggest any antimicrobial or germicidal efficacy which may be attained by his compositions it is contended that there would be absolutely no teaching or motivation to consider the Charlez compositions as having any possible antimicrobial or germicidal benefit whatsoever, and thus there would be no expectation of such a property, and moreover there would be no motivation to alter the Charlez compositions in any way in order to achieve any degree of antimicrobial efficacy against both Gram positive and Gram negative bacteria as now claimed. Thus the legal standard for maintaining the current ground of rejection is not met, and the applicant believes that the current rejection should be withdrawn.

Regarding the rejection of claim 12 under 35 USC 103(a) as being considered obvious in view of US 2002/0069901 to Evers:

The applicant respectfully traverses the Examiner's rejection of the claims over the Evers reference.

The applicant herein repeats the remarks entered, *supra*, with respect to the rejection under 102(b) in view of the Evers document as being equally relevant to the current obviousness-type rejection. As discussed previously, the Evers document fails to teach or to even remotely suggest any antimicrobial or germicidal efficacy which may be attained from his compositions and as such, it is fair to say that there would be absolutely no teaching or motivation to consider the Evers compositions as having any possible antimicrobial or germicidal benefit whatsoever. Similarly as there would be no expectation of such a property, logically there would also be no motivation to alter the Evers compositions in any way in order to achieve any degree of antimicrobial efficacy against both Gram positive and Gram negative bacteria as is now claimed. Thus the legal

US Serial No. 10/530427
Page 13 of 19

standard for maintaining the current ground of rejection is not met, and the applicant believes that the current rejection should be withdrawn.

Regarding the rejection of claims 21-23 and 25 under 35 USC 102(b) or alternately under 35 USC 103(a) as being considered obvious in view of US 6001795 to Charlez, US 2002/0069901 to Evers or WO94/14945:

The applicant respectfully traverses the Examiner's rejection of the claims over the combined references.

The rejection against claim 21 and 22 is considered moot as these claims have been canceled in the present paper, however claims 23 and 25 remain.

The applicant herein repeats the remarks entered, *supra*, with respect to the rejection under 102(b) and/or 103(a) in view of the Charlez, Evers and WO 94/14945 documents as being equally relevant to the current obviousness-type rejection lodged against claims 23 and 25.

As claims 23 and 25 are further dependent claims from claim 1, which has been amended to specifically recite a "germicide system" which is believed to render that claim novel and inventive over the prior art, accordingly dependent claims 23 and 25 are properly also considered to be novel and inventive over the prior art as well. As noted above, each of the Charlez, Evers and WO 94/14945 documents are devoid of any reference to or suggestion of any germicidal efficacy or of any germicidal benefit provided by those compositions. Claim 23 which is subordinate to claim 1 adds a further limitation as to a specific degree of antimicrobial efficacy against *Salmonella choleraesuis*; as each of Charlez, Evers and WO 94/14945 are individually and collectively silent as to any reference to a germicidal benefit, it is not seen this claim can be considered to be anticipated or obvious over these prior art documents which make no mention of, nor make no demonstration of such a property. Claim 25 which is subordinate to claim 1

US Serial No. 10/530427
Page 14 of 19

adds a further limitation as to the exhibition of a "blooming" effect when diluted in water. As claim 1 requiring germicidal efficacy of the compositions is both novel and nonobvious over the prior art, logically the subordinate claim 25 should also be considered both novel and nonobvious over the prior art.

In view of the foregoing, reconsideration of the propriety of the rejections of claims 23 and 25 over the Charlez, Evers and WO 94/14945 documents, and withdrawal of the rejection is solicited.

Regarding the rejection of claim 12 under 35 USC 103(a) as being considered obvious in view of US 6001795 to Charlez further in view of US 2002/0069901 to Evers:

The applicant respectfully traverses the Examiner's rejection of the claims over the Evers reference.

With regard to claim 12, it is pointed out that Claim 12 has been rewritten as a dependent claim which is now subordinate to claim 1 adds a further limitation as to the use of benzyl alcohol in the compositions of claim 1. However, as has been discussed *supra*, as claim 1 requiring germicidal efficacy of the compositions is both novel and nonobvious over the prior art, logically the subordinate claim 12 should also be considered both novel and nonobvious over the prior art. Nothing in Charlez or Evers teaches the selection of any specific constituents in order to provide a "germicide system" and nothing in either of these documents teaches or suggests the selection of benzyl alcohol in providing any beneficial germicidal effect in conjunction with any further constituent.

Accordingly, reconsideration of the propriety of the rejections of claim 12 over the combined Charlez and Evers references, and withdrawal of the rejection is solicited.

US Serial No. 10/530427
Page 15 of 19

Regarding the rejection of claim 14 under 35 USC 103(a) as being considered obvious in view of US 6001795 to Charlez or US 2002/0069901 to Evers in further view of WO00/49127 or US 2002/0119902 :

The applicant respectfully traverses the Examiner's rejection of the claims over the Evers reference.

With regard to claim 14, it is pointed out that Claim 14 has been rewritten as a dependent claim which is now subordinate to claim 1 adds a further limitation as to the use of propylene glycol phenyl ether in the compositions of claim 1. However, as has been discussed *supra*, as claim 1 requiring germicidal efficacy of the compositions is both novel and nonobvious over the prior art, logically the subordinate claim 12 should also be considered both novel and nonobvious over the prior art.

The Examiner's reliance on WO 00/49127 to cure the shortcomings of the Evers and Charlez references is also believed to be inappropriate as well as inadequate. As a review of the WO 00/49127 document quickly reveals, the germicidal benefit provided by those compositions stems from the use of a quaternary ammonium compound (see pages 2, 3; and Ex. 1 and Ex. 2 at "Table 1" page 30). It is clear that the germicidal benefit of WO 00/49127 is effective but is distinguishable from the "germicide system" according to the present invention, although such a quaternary ammonium compound can be an optional constituent of the presently claimed compositions. However it would only be clear to a skilled artisan that the WO 00/49127 compositions would be inoperative as to germicidal effectiveness if the quaternary ammonium compound were omitted. It would not be clear to a skilled artisan considering the WO 00/49127 reference that any other constituents could be germicidally effective. Thus the Examiner's reliance upon the WO 00/49127 to cure the defects of the Evers and Charlez references is believed to be inappropriate, and withdrawal of the rejection is requested.

US Serial No. 10/530427
Page 16 of 19

With regard now to the Examiner's reliance on US 2002/0119902 to cure the shortcomings of the Evers and Charlez references, it is similarly believed that such reliance is inappropriate as well as inadequate. The compositions of the US 2002/0119902 is rather nonspecific as to the identification of any of the one or more constituents which are believed to be responsible for the observed antimicrobial benefit which those compositions provide. (see para. [0039] of US 2002/0119902.) With respect to the sole example (at page 5 of US 2002/0119902) therein is provided a composition which comprises 8 constituents, inclusive of two different surfactants (sodium lauryl sulfate, alkyl polyglycoside), three different organic surfactants (propylene glycol n-hexyl ether, ethylene glycol hexyl ether, isopropanol), sodium hydroxide and sodium bicarbonate, fragrance and water. It is the present applicant's contention that it would not be clear to a skilled artisan considering the US 2002/0119902 reference which of those constituents provide antimicrobial efficacy, and as such it is not seen how the non-specific discussion at para. [0039] would provide any motivation or expectation of success as modifying the Evers or Charlez reference in order to arrive at the presently claimed invention. Thus the Examiner's reliance upon the US 2002/0119902 to address the defects of the Evers and Charlez references is believed to be inapplicable. Reconsideration of the propriety of the rejection and its withdrawal is solicited.

Regarding the rejection of claims 21-23 under 35 USC 102(b) as being anticipated by US 6001795 to Charlez or alternately under 35 USC 103(a) as being considered obvious in view of Charlez:

The applicant respectfully traverses the Examiner's rejection of the claims over the Charlez reference.

As claims 21 and 22 have been canceled in the present paper, the rejection lodged against those claims is moot.

US Serial No. 10/530427
Page 17 of 19

With respect to claim 23, as claim 23 is subordinate to and dependent from claim 1 which has been amended to specifically recite a "germicide system" which is believed to render that claim novel and inventive over the prior art, accordingly dependent claim 23 is properly also considered to be novel and inventive over the prior art as well.

With respect to the current rejection, as the Charlez document fails to teach or suggest any antimicrobial or germicidal efficacy provided by his compositions, it is the applicant's position that Charlez provides no teaching or motivation for a skilled artisan to consider the Charlez compositions as having any antimicrobial or germicidal benefit whatsoever. Thus there would be no expectation of such a property, and there would be no motivation to alter the Charlez compositions in any way in order to achieve any degree of antimicrobial efficacy against both Gram positive and Gram negative bacteria as now claimed. Accordingly, reconsideration of the propriety of the rejection against claim 23 and its withdrawal is requested.

Regarding the provisional "double patenting" rejection of claims in view of copending applications Ser.No. 10/530433, 10/530372 and 10/530926:

The applicant traverses the Examiner's assertions that the subject matter of the present application and those of copending applications 10/530433, 10/530372 and 10/530926 are not patentably distinct. The applicant notes the Examiner's provisional "double patenting" rejection of the claims in view of copending applications 10/530433, 10/530372 and 10/530926. As the applicant notes, the Examiner has correctly pointed out that this is a provisional double patenting rejection and as neither of the applications have been allowed, nor have allowable claims been indicated in either application, the applicant is of the position that said double patenting rejection remains premature. However, upon the allowance of claims in either application, the Examiner is invited to

US Serial No. 10/530427
Page 18 of 19

reinstate the provisional double patenting rejection for consideration and action by the applicant.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

Early issuance of a *Notice of Allowability* is requested.

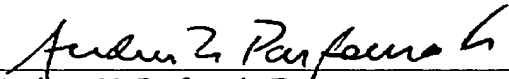
PETITION FOR A TWO-MONTH EXTENSION OF TIME

The applicants respectfully petition for a two-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;


Andrew N. Parfomak, Esq.
Reg.No. 32,431
Norris, McLaughlin & Marcus, PC
875 Third Avenue, 18th Floor
New York, NY 10022

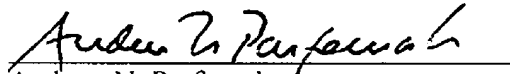

Date:

Tel: 212 808-0700

US Serial No. 10/530427
Page 19 of 19

CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-272-8300 on the date shown below:


Andrew N. Parfomak


Date

C:\ANPCMB\102792\433\Amendment01.doc